

REMARKS

Applicant respectfully requests reconsideration of the instant application in view of the above amendments and the following remarks. Claims 101, 111, 112, 118 and 119 have been amended by way of this Response. Applicant submits that support for the amendments may be found throughout the originally filed specification, drawings and claims and that no new matter has been added by way of this Amendment/Response. Claims 53-124 are currently pending

Applicant thanks the Examiner for the indication that claims 70-73, 94-97 and 118-121 include allowable subject matter and would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. (March 31, 2008 Office Action, p. 6, § 7).

Specification

Applicant includes herewith an amendment to the specification to reflect the claim for priority of the instant Continuation application. Applicant submits that support for the amendments may be found throughout the originally filed specification, drawings, and claims, and that no new matter has been added by way of the foregoing amendments. In particular, Applicant notes that the claim to priority is already properly indicated on the filing receipt for the instant application. Accordingly, Applicant respectfully requests entry of this amendment.

Claim Rejection Under 35 USC § 101

The Examiner has rejected claims 101-124 under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter. Specifically, the Examiner alleges that independent claim 101 "fails to define any structural and functional interrelationships between

the computer program and other elements of a computer that permit the computer program's function to be realized." (March 31, 2008 Office Action, p. 4, § 4).

Although Applicant respectfully traverses the Examiner's rejection and maintains that the claims in their original form are directed to statutory subject matter, Applicant has amended claims 101, 111, 112, 118 and 119 to provide clarification and to better track current business practices. Amended claim 101 recites, *inter alia*, "A processor-accessible medium for providing a user with a customized healthcare services insurance package, comprising: processor readable instructions stored in the processor-accessible medium, wherein the processor readable instructions are issuable by a processor . . ." Accordingly, Applicant respectfully requests reconsideration and withdrawal of this basis of the Examiner's rejection. Should the Examiner disagree, Applicant respectfully requests additional clarification as to how the Examiner believes the claims are allegedly directed to non-statutory subject matter.

Double Patenting

The Examiner has rejected claims 53-76 on the ground of nonstatutory obviousness-type double patenting as allegedly being unpatentable over claims 1-19 of U.S. Patent No. 6,735,569, and has rejected claims 77-124 on the ground of nonstatutory obviousness-type double patenting as allegedly being unpatentable over claims 20-38 of U.S. Patent No. 6,735,569. Applicant submits herewith a terminal disclaimer for the instant application. Accordingly, Applicant submits that the issues raised by the Examiner with regard to the pending double patenting rejection over U.S. Patent no. 6,735,569 have been rendered moot.

Claim Rejection Under 35 USC § 103

The Examiner has rejected claims 53-67, 73-91, 98-115 and 122-124 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Tawil (US Patent No. 5,519,607; hereinafter, "Tawil") in view of Campbell et al. (US Patent No. 6,208,974; hereinafter, "Campbell"). Applicant respectfully traverses the Examiner's rejection and submits that a prima facie case of obviousness has not been established and that the pending claims are patentably distinct from the cited references, taken alone or in combination, for at least the following reasons.

MPEP § 706.02(j) prescribes that a rejection under 35 U.S.C. § 103 should set forth:

- (i) the relevant teachings of the prior art relied upon,
- (ii) the differences in the claim over the applied references,
- (iii) the proposed modification of the applied references to arrive at the claimed subject matter, and
- (iv) an explanation as to why the claimed invention would have been obvious to one of ordinary skill in the art at the time the invention was made.

Applicant submits that the rejections in the pending Office Action do not establish each of these requirements.

Applicant submits that the rejections in the March 31, 2008 Office Action fail to establish the relevant teachings of the prior art relied upon and differences in the claim over the applied references by not addressing every claim limitation. The MPEP prescribes that, "when evaluating the scope of a claim, *every limitation in the claim must be considered*," [§ 2106 II(C), emphasis added] and, "*All words* in a claim must be considered in judging the patentability of that claim against the prior art." [§ 2143.03, emphasis added].

By way of example only, Applicant submits that the pending rejection has cited no reference nor taken Official Notice with respect to at least the claim element "using a computer system to determine a healthcare services insurance package based on a user's selection

and the financial parameter," as recited in independent claim 53. The pending rejection alleges that, "Campbell teaches a method of further comprising the steps of: determining a healthcare services package based on the user's selection and a financial parameter (col. 21, lines 22-29; col. 24, lines 1-55; col. 27, lines 1-49 . . .)." (March 31, 2008 Office Action, p. 8, § 3). However, Applicant submits that the pending claim does not recite, "determining a healthcare services package," but rather, "using a computer to determine a healthcare services insurance package." Campbell's system is directed to managing a wellness plan and fails to disclose or suggest a "healthcare services insurance package" as recited in independent claim 53. Accordingly, Applicant submits that the pending rejection fails to consider "all words in [the] claim," as required, for example, by MPEP § 2143.03, and respectfully requests reconsideration and withdrawal of this basis of the Examiner's rejection. Should the Examiner disagree, Applicant respectfully request that the Examiner provide clarification as to how Campbell discusses "using a computer to determine a healthcare services insurance package based on a user's selection and the financial parameter," as recited in independent claim 53.

Furthermore, Applicant submits that the rejection in the March 31, 2008 Office Action has not established why the claimed invention would have been obvious to one of ordinary skill in the art at the time the invention was made by not treating the claims as wholes, by not providing a discussion of the level of ordinary skill in the art, and by applying impermissible hindsight.

MPEP § 2141.02 (I) states, "In determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious." [See, MPEP § 2141.02(I); original emphasis]. MPEP § 2106 (II)(C), states *inter alia*:

"USPTO personnel may not dissect a claimed invention into discrete elements and then evaluate the elements in isolation. Instead, the claim as a whole must be considered." Applicant submits that the pending rejection concludes obviousness of claim elements in isolation and not in respect to the claim elements recited in each claim taken as a whole. By way of example only, Applicant notes that the pending rejection has cited two different and disparate concepts from the two references as allegedly anticipating the same claim element, "a financial parameter". At first, the rejection cites Tawil as allegedly discussing the claim element "receiving personal information data, wherein personal data comprises a user identifier and a financial parameter," and alleges "the system stores data on the amount of benefits or a fixed amount the patient can/will spend on healthcare (i.e. financial parameter). (col. 2, lines 53-56 [of Tawil])." (March 31, 2008 Office Action, pp. 7-8, § 9). However, the rejection then goes on to cite Campbell as allegedly discussing the claim element, "using a computer system to determine a healthcare services insurance package based on a user's selection and the financial parameter," by alleging, "[t]he determined wellness plan (i.e. health care services package) is based on the user/client's selections and the estimated costs/cost savings for services under the plan (i.e., a financial parameter)." (March 31, 2008 Office Action, p. 8, § 9). Applicant submits that, by treating the two recitations of "financial parameter" in the claim independently, the pending rejection has dissected the claim into discrete elements and evaluated the elements in isolation, as forbidden by MPEP § 2106 (II)(C), and has not established whether the claimed invention as a whole would have been obvious, as required by MPEP § 2141.02(I). Accordingly, Applicant respectfully requests reconsideration and withdrawal of this basis of the Examiner's rejection.

Applicant also submits that the pending rejection has provided no indication of the level of ordinary skill in the art. MPEP § 2141 (II)(C) states, "Any obviousness rejection

should include, either explicitly or implicitly in view of the prior art applied, an indication of the level of ordinary skill." The pending rejection refers to, "one of ordinary skill in the art," (See, e.g., March 31, 2008 Office Action, p. 9, ¶ 2) but has provided no indication or discussion of which art is described or the level of ordinary skill associated therewith. The rejection's reference to "the art" is overly general and, consequently, does not provide a specific indication of the level of ordinary skill pertinent to the claimed subject matter. MPEP § 2141.03 (III) states, "The importance of resolving the level of ordinary skill in the art lies in the necessity of maintaining objectivity in the obviousness inquiry." Applicant submits that impermissible hindsight has been applied in asserting obviousness of the various claim elements without providing an indication of the level of ordinary skill. As such, Applicant respectfully requests that, if the Examiner maintains this rejection, the Examiner discuss the level of ordinary skill in the art at the time of the invention and clarify how the claimed subject matter would have been obvious to one possessing that level of skill.

Although of different scope than claim 53, Applicant submits that claim 77 is patentable over Tawil in view of Campbell for at least similar reasons as discussed above identifying deficiencies in both Tawil and Campbell with regard to independent claim 53. For example, independent claim 77 recites, *inter alia*:

A computerized system . . . , comprising:
 ...
 using a computer system to determine a healthcare services
 insurance package based on a user's selection and the financial
 parameter; and
 ...

Applicant respectfully submits that at least these claim elements from independent claim 77 are not discussed or rendered obvious by Tawil, which discusses a treatment plan

processing system, nor by Campbell, which discusses a system for generating wellness plans, as discussed above.

Although of different scope than claim 53, Applicant submits that claim 101 is patentable over Tawil in view of Campbell for at least similar reasons as discussed above identifying deficiencies in both Tawil and Campbell with regard to independent claim 53. For example, amended independent claim 101 recites, *inter alia*:

A processor-accessible medium. . ., comprising:

...
using a computer system to determine a healthcare services
insurance package based on a user's selection and the financial
parameter; and

...

Applicant respectfully submits that at least these claim elements from independent claim 101 are not discussed or rendered obvious by Tawil, which discusses a treatment plan processing system, nor by Campbell, which discusses a system for generating wellness plans, as discussed above.

Furthermore, Applicant submits that claims 54-76, 78-100 and 102-124, which are directly or indirectly dependent from independent claims 53, 77 and 101 respectively, are also not taught, anticipated, or rendered obvious by the cited references, taken alone or in combination, for at least the reasons discussed above. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the Examiner's rejection for these claims as well.

CONCLUSION

Consequently, the reference(s) cited by the office action do not result in the claimed invention, there was/is no motivation for such a combination of references (i.e., cited references do not teach, read on, suggest, or result in the claimed invention(s)), and the claimed

inventions are not admitted to be prior art. Thus, the Applicant respectfully submits that the supporting remarks and claimed inventions, claims 53-124, all: overcome all rejections and/or objections as noted in the office action, are patentable over and discriminated from the cited reference(s), and are in a condition for allowance. Furthermore, Applicant believes that the above remarks, which distinguish the claims over the cited reference(s), pertained only to noted claim element portions. These remarks are believed to be sufficient to overcome the prior art. While many other claim elements were not discussed, Applicant asserts that all such remaining and not discussed claim elements, all, also are distinguished over the prior art and reserves the opportunity to more particularly remark and distinguish such remaining claim elements at a later time should it become necessary. Further, any remarks that were made in response to an Examiner objection and/or rejection as to any one claim element, and which may have been re-asserted as applying to another Examiner objection and/or rejection as to any other claim element(s), any such re-assertion of remarks is not meant to imply that there is commonality about the structure, functionality, means, operation, and/or scope of any of the claim elements, and no such commonality is admitted as a consequence of any such re-assertion of remarks. As such, Applicant does not concede that any claim elements have been anticipated and/or rendered obvious by any of the cited reference(s). Accordingly, Applicant respectfully requests allowance, and the reconsideration and withdrawal of the rejection(s) and/or objection(s).

If a telephone conference would facilitate prosecution of this application in any way, the Examiner is invited to contact the undersigned at the number provided.

AUTHORIZATION

The Commissioner is hereby authorized to charge any additional fees which may be required for consideration of this Amendment to Deposit Account No. 03-1240, Order No. 17231-004US1.

In the event that an extension of time is required, or which may be required in addition to that requested in a petition for an extension of time, the Commissioner is requested to grant a petition for that extension of time which is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to Deposit Account No. 03-1240, Order No. 17231-004US1.

Respectfully submitted,
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